

Response Under 37 C.F.R. §1.116 – Expedited Examining Procedure

Serial No.: 09/818,240

Confirmation No.: 1590

Filed: 27 March 2001

For: ROLL GOODS DISPENSER SYSTEM AND METHODS OF USE

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Applicants traverse this rejection and submit that claims 1-32 meet the requirements of 35 U.S.C. § 112, first paragraph. The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. See MPEP § 2164.04, pp. 2100-178 to 2100-179. An enablement rejection should provide the "factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation" *Id.* at p. 2100-179 (emphasis in original).

In the present rejection the Examiner has asserted that "[i]t is not clear what kind of force is required and how the force is to be applied." While these assertions may provide some of the reasons as to why the Examiner concludes that the specification fails to teach how to use the invention, it does not address why the Examiner believes that one of ordinary skill would not be able to determine how to use the invention without undue experimentation. The failure to provide any evidence or reasoning on that point alone indicates that the Examiner has not met his burden in establishing a *prima facie* case of non-enablement.

Furthermore, Applicants note that the Examiner has not addressed the teachings in the specification that discuss a variety of methods of how to use the invention. Applicants respectfully direct the Examiner's attention to, e.g., page 9, lines 9-14:

In some instances, the side shields 22 and 32 may be closed by first placing the roll goods dispenser system 10 on a flat surface with side shield 22 laid flat on the surface, and then exerting a force on the side shield 32 such that the force returns the side shield 32 directly to the closed position, and returns the side shield 22 to the closed position by compressing the system 10 against the flat surface.

In the above excerpt, the specification indicates that a compressive force (i.e., the "kind of force") is to be used to close the device, and that the compressive force is to be applied to the sides of the device (i.e., "how the force is to be applied").

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Furthermore, Applicants submit that in a predictable art area such as that of the present invention, one of ordinary skill in the art would be able to determine how to open the device based on the above excerpt and all of the teachings of the specification. Those teachings include the figures, which clearly depict the device in its open and closed configurations. Furthermore, in the absence of evidence to the contrary, Applicants submit that one of ordinary skill in the art understands the physical properties of the materials used to manufacture the device (e.g., the elastomeric materials used for the sides) and how they would react to the application of a variety of forces, e.g., compression, tension, bending, etc.

Applicants respectfully submit that, given the above, one of ordinary skill in the art would be able to determine how the side shields are movable from the closed configuration to the open configuration without undue experimentation. Furthermore, as noted above, the Office Action fails to provide any reasoning or evidence as to why one of ordinary skill in the art would be able to use the invention without undue experimentation.

For at least the above reasons, Applicants submit that claims 1-32 meet the requirements of 35 U.S.C. § 112, first paragraph. Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

The 35 U.S.C. §103 Rejection

The Examiner rejected claims 1-32 under 35 U.S.C. §103(a) as being unpatentable over Bishop (U.S. Patent No. 474,518). Applicants respectfully traverse this rejection.

Specifically, the Examiner alleges that the side shields (A) of Bishop are concave in the same way as applicant's device. The Examiner further notes that the shields (A) can be removed from the core and positioned with the outside walls facing the roll, therefore forming a convex shape facing the roll. It is deemed that there is friction between the plugs (B) and core (C) (as opposed to being frictionless) therefore forming a "friction fit." All the pieces are attached together as shown in the figures. The Examiner alleges that adhesive tape would have been an

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obvious choice of material to be used in conjunction with the apparatus, which would facilitate the device opening to facilitate dispensing, if desired.

Applicants traverse this rejection as failing to meet the requirements for a *prima facie* case of obviousness. Specifically, the Office Action fails to present a proper motivation or suggestion to modify the teachings of Bishop as asserted. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. See MPEP § 2143.01, pp. 2100-124 to 2100-125. In the asserted rejection, modifying Bishop in the manner suggested would render the device taught by Bishop unsatisfactory for its intended purpose, thus negating the asserted motivation or suggestion required for a *prima facie* case of obviousness.

The Office Action alleges that end pieces (A) of Bishop "can be removed from the core and positioned with the outside walls facing the roll therefore forming a convex shape facing the roll." Applicants first note that there is no motivation or suggestion identified in the prior art to make such a modification in Bishop. Further, turning one or both end pieces (A) around would leave the ribbon exposed to external elements and possible damage. This is in direct contrast to the teachings of Bishop, where the case is "designed to furnish a neat package for the ribbon, to completely protect it from damage, rough handling or the oxidizing effect of the atmosphere." See Bishop, page 1, lines 7-10.

Furthermore, turning one of both of the end pieces of Bishop around as asserted would also result in the lugs (B) facing away from the core or bobbin on which the ribbon is wound. As discussed in Bishop, the lugs (B) are provided to support the core or bobbin. Providing them on the outside of the end pieces (A) would result in the core or bobbin being unsupported. If unsupported, the ribbon would not be retained within the end pieces, thereby further subjecting it to damage.

Turning one or both end pieces (A) around as asserted would, therefore, render Bishop unsatisfactory for its intended purpose of protecting ribbon from damage and oxidation, thereby

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negating the asserted motivation or suggestion to modify Bishop to reach a *prima facie* case of obviousness.

For at least the above reasons, Applicants submit that claims 1-32 are not *prima facie* obvious in view of Bishop. Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

Summary

It is respectfully submitted that the pending claims 1-32 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
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26 FEB 2003
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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Assistant Commissioner for Patents, Attn: BOX AF, Washington, D.C. 20231, on this 26th day of February, 2003, at 11:20 a.m. (Central Time).

By:

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